

REMARKS

At the time of the Office Action dated March 19, 2007, claims 1-25 were pending and rejected in this application. Independent claims 1, 7, 13, and 19 have been amended to clarify that a user is able to access a supplier catalog, which is separate from the aggregated catalog, and adequate descriptive support for these limitations can be found throughout the originally-filed disclosure, for example, on page 6, lines 21-26. Claims 21-25 have been cancelled. Applicants submit that the present Amendment does not generate any new matter issue.

CLAIMS 1-3, 6-9, 12-15, 18-19, 21-23, AND 25 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY HAYNES ET AL., U.S. PATENT PUBLICATION NO. 2006/0218052 (HEREINAFTER HAYNES)

On pages 2-4 of the Office Action, the Examiner asserted that Haynes discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.

Haynes being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Despite these requirements, the Examiner's statement of the rejection simply consists of the Examiner repeating, almost word-for-word, each of the recited claims and asserting that the entire claim is disclosed by certain specified passages within Haynes. The manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in Haynes being relied upon in the rejection.

It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within Haynes being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within the applied prior art that identifies the feature that corresponds to the claimed element. However, merely citing a long passage or an entire paragraph to disclose a single (or multiple) claimed elements does not designate "as nearly as practicable," the particular features within Haynes being relied upon by the Examiner in the rejection.

For example, the Examiner cites to paragraph [0018] of Haynes to identically disclose the following claimed limitations in claim 1:

receiving a plurality of supplier catalogs from said plurality of suppliers;
aggregating said plurality of supplier catalogs into an aggregated catalog.

For ease of reference, paragraph [0018] is reproduced below:

In another aspect of this invention, there is described a method of constructing a searchable database that stores at least one catalogue of items that may be bought by at least one buyer and are supplied by at least one supplier. The method comprises the steps of the one supplier selecting which of its items that are to be included in its catalogue, the supplier attaching to each selected item a description of that item and, then, storing each item and attached description in a database. Thus the buyer is entitled to search the catalog of items stored in the database based on the descriptions of the items.

This passage, however, is silent as to (i) a plurality of supplier catalogs; (ii) receiving the plurality of supplier catalogs; (iii) a plurality of suppliers; (iv) aggregating the plurality of supplier catalogs; and (v) an aggregated catalog.

Part of the process of examination is to construe meanings for claimed terms. Presuming that the applied prior art does not unquestionably identically disclose a particular claimed limitation, the Examiner is obligated to construe a meaning for the claimed limitation and explain why a teaching of the applied prior art identically discloses that claimed limitation based upon the Examiner's claim construction for the claimed limitation. This analysis, however, has not been performed for any of the claim limitations.

Appellants are presuming that the Examiner is intending to argue that the searchable database corresponds to the claimed catalog. However, a searchable database does not identically disclose the claimed catalog. A searchable database may be a tool that a user can use in conjunction with a catalog. However, a database and a catalog are not identical. A catalog is

a list of items that are accessible by a user, as a list. A database, however, is not necessarily accessible by a user, as a list of items. Given the ordinary and customary meaning of the term "catalog," the database of Haynes fails to teach this limitation.

Moreover, Applicants note that claims 1, 7, 13, and 19 have been amended to clarify that a user is able to access a supplier catalog, which is separate from the aggregated catalog. This limitation is neither taught nor suggested by Haynes.

Claim 3

On page 3 of the Office Action, the Examiner relied upon paragraph [0048] to teach "said buyer accesses said aggregated catalog through one of said hosted supplier stores owned by one of said suppliers." For ease of reference, paragraph [0048] is reproduced below:

As shown in FIG. 1, each of the buyers' terminals 16 and each of the vendors' or suppliers' terminals 14 is coupled to a web server 20, which in one illustrative embodiment of this invention may take the form of a Microsoft Internet information server. In particular the server 20 is programmed to manage a buyer site 22a and a vendor or supplier site 22b. In particular, the buyer site 16 generates and transmits certain web pages or screens to a selected one of the buyer terminals 16. The buyer screens are shown in FIG. 3 and facilitate, in a general sense, each buyer to conduct a search for at least one, particular product and/or service, to obtain if needed further information about the preliminarily chosen product or service, to combine with a further marking such as a trademark, logo or the like if needed, and to place an order, which is transmitted through an interface to that vendor of the selected product or service.

Referring to Fig. 1, the buyer (i.e., presumably feature 16) accesses information via the buyer site 22a. However, Applicants are unclear where Haynes teaches that the buyer site is "owned by one of said suppliers," as claimed.

The above argued differences between the claimed invention and the teachings of Haynes undermine the factual determination that Haynes identically describes the claimed invention within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully submit that the imposed

rejection of claims 1-3, 6-9, 12-15, and 18-19 under 35 U.S.C. § 102 for anticipation based upon Haynes is not factually viable and, hence, solicit withdrawal thereof.

CLAIMS 4-5, 10-11, 16-17, 20, AND 24 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON HAYNES IN VIEW OF FLAXER ET AL., U.S. PATENT PUBLICATION NO. 2003/0033218 (HEREINAFTER FLAXER)

On pages 4 and 5 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have arrived at the claimed invention based upon the combination of Haynes and Flaxer. This rejection is respectfully traversed.

Claims 4-5, 10-11, and 16-17 respectively depend from independent claims 1, 7, and 13, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1, 7 and 13 under 35 U.S.C. § 102 for anticipation based upon Haynes. The secondary reference to Flaxer does not cure the argued deficiencies of Haynes. Accordingly, even if the claimed invention were combined in the manner suggested by the Examiner, the proposed combination of references would not yield the claimed invention. Therefore, Applicants respectfully submit that the imposed rejection of claims 4-5, 10-11, and 16-17 under 35 U.S.C. § 103 for obviousness based upon Haynes in view of Flaxer is not viable and, hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the

prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 18, 2007

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